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Remarks

Reconsideration of the present application is respectfully requested.

The indication of the allowability of some of the claims in the present application is acknowledged with appreciation.

102(b) – Anticipation Rejections.

The rejection of claims 1-6, 9-10, 13, 15, 18, 21 and 22 under 35 U.S.C. 102(b) as being anticipated by Greenberg et al. (US 6,104,558) is respectfully traversed.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP 2131. Claim 1 of the present application discloses “... determining a location within a cycle by reading a portion of a cyclic bit sequence, the bit sequence containing several interspersed bit-group sets that each contain a plurality of series that each consist of several consecutively-placed identical bit-groups.” Greenberg does not disclose “several consecutively-placed identical bit-groups” (emphasis added) as required by Claim 1. The four bit groups that the Examiner points out as depicted in Greenberg Fig. 5 are merely consecutive, but not identical. The bit groups in Fig. 5 differ in that the Index will be a single 1 or 0, while the track number, sector number, and head number will all be strings of bits that are all different. In column 8, lines 24-32 this non-identical characteristic is exemplified by disclosing bit groups that range in length from 1 bit to 11 bits. Since Claim 1 requires the consecutive bit-groups to be identical, Greenberg fails to identically or inherently describe every element of Claim 1.

Therefore, it is submitted that Greenberg does not anticipate claim 1 as well as dependent claims 2-6, 9, 10, and 13. The corresponding apparatus claims 15, 18, 21, 22 are submitted as not anticipated by Greenberg for similar reasons.

103(a) – Obviousness Rejections.

The rejection of claims 17, 20 and 24 under 35 U.S.C. 103(a) as being obvious over Greenberg et al. (US 6,104,558) in view of Codilian et al. (US 6,934,114) is respectfully traversed.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP 2143.

Greenberg fails to specifically disclose more than just “servo sectors occupying a total area A, the bit-groups occupying a smaller area B<2% of A” as stated in the Office Action. Greenberg also fails to specifically disclose “identical bit-groups” recited in Claim 15 for the reasons discussed above. Likewise, Codilian fails to disclose “identical bit-groups” as well. This limitation of Claim 1 is not explicitly taught in either reference and the Examiner has provided no objective evidence that either reference suggests the limitation in Claim 1. Therefore, the combination of Greenberg with Codilian does not “teach or suggest all the claim limitations” in claims 17, 20, and 24 and a prima facie case of obviousness cannot be made.

Notwithstanding this fact, it is not clear that the cited reference, Codilian, teaches a bit group occupying <2% of the total area of the servo sector. Codilian merely teaches a bit group (wedge ID) that is 2 bits in length, meaning that if the total length of the servo sector is <100 bits, then Codilian’s wedge ID would not fall within the range of <2% of the total area.

Further, Codilian teaches away from the invention disclosed in claims 17, 20, and 24. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983); MPEP 2141.02. The figure described in Codilian in col.7, lines 32-40 (Figure 5A) provides evidence of how this cited prior art teaches away from claims 17, 20, and 24. The reduced bit wedge ID numbers (504) in

Codilian Fig. 5A show that the bit groups are unique, as opposed to identical, for each sequential sector wedge (00, 01, 00, 10, 00, etc.). Compare to Fig. 7 of the present application that shows the identical bit groups described in the claims. In Fig. 7 the sets 600, 601, 610, & 611 show a series of consecutive identical bit-groups (00, 00, 00, 00, 01, 01, 01, 01, 10, 10, etc.) that Condilian teaches away from. Therefore it would not have been obvious to one of ordinary skill in the art at the time of the invention to combine Codilian with Greenberg in a manner that renders the claimed invention obvious.

In view of the above discussions, claims 17, 20, and 24 are not obvious over the applied references and are therefore allowable.

No Reasoning Provided for Rejecting Claim 25.

The examiner on the Office Action Summary page indicated the rejection of claim 25, but no references were cited or reasoning for rejection discussed in the Detailed Action. "In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command." 37 C.F.R. 1.104(c)(2). Since no basis for rejecting this claim was provided, no meaningful response could be submitted. The Applicant requests that the next Office Action be made **non-final** and respectfully asks for a basis of rejection regarding claim 25, if one still exists.


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Conclusion

The Reply is believed to be responsive to all points raise in the Office Action. Accordingly, prompt allowance and passage of the application to issue are earnestly solicited. Should the Examiner have any remaining questions or concerns, he/she is encouraged to contact the undersigned attorney by telephone to expeditiously resolve such concerns.

Respectfully submitted,

SEAGATE TECHNOLOGY LLC
(Assignee of Entire Interest)9/18/06
Date
David K. Lucente, Reg. No. 36,202
Patent Attorney
SEAGATE TECHNOLOGY LLC
Intellectual Property Dept. - COL2LGL
389 Disc Drive
Longmont, CO 80503
720-684-2295 (telephone)
720-684-2588 (facsimile)